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Docket No.: SON-417
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent No. 5,453,758 of:
Kazuhiro SATO

Issued: September 26, 1995

Application No.: 08/098,896

Filed: July 29, 1993

For: INPUT APPARATUS

#17

RECEIVED

DEC 06 2007

OFFICE OF PETITIONS

**PETITION FOR RECONSIDERATION UNDER (37 C.F.R. §1.378(B))
OF THE DECISION ON PETITION OF SEPTEMBER 28, 2007**

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Petition is a full and timely response to the Decision on Petition ("the Decision") mailed on September 28, 2007 dismissing the Petition for Reconsideration Under (37 C.F.R. §1.378(e)) of the Decision on Petition of May 17, 2007. Reexamination and reconsideration in light of the following remarks are courteously requested.

Pursuant to 37 C.F.R. §1.378(e), any such petition for reconsideration must be accompanied by the petition fee required by 37 C.F.R. §1.17(f). Accordingly, the petition fee being submitted is \$400.00.

The Commissioner is hereby authorized to charge the petition fee of **\$400.00** to Deposit Account No. #18-0013. If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account No. #18-0013.

04/07/2009 CKHLOK 00000004 100013 5453758

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A copy of the Notice of Non-Acceptance of Patent Maintenance Fee is provided along with this Renewed Petition as ATTACHMENT B.

RELIEF

Applicant hereby petitions the Commissioner under 37 C.F.R. §1.378(e) to issue a decision granting the Petition To Accept Unavoidably Delayed Payment Of Maintenance Fee In An Expired Patent (37 C.F.R. §1.378(b)) filed on June 30, 2006.

Applicant further requests acceptance of the 11 ½ year maintenance fee.

The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account # 18-0013.

Dated: November 28, 2007

Respectfully submitted,

By 

Ronald P. Kananen

Registration No.: 24,104

Brian K. Dutton

Registration No.: 47,255

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 23353

(202) 955-3750

Attorney for Applicant

ARGUMENT

Generally

The Decision appears to be focused primarily on procedures then existing within Sony regarding the instance where a reissue application was pending and the underlying patent had not lapsed.

In response, U.S. patent practice and procedures dictate that maintenance fees are required to be paid in all patents based on applications filed on or after December 12, 1980. 37 C.F.R. §1.362(a). As a consequence, this section found within Title 37 of the Code of Federal Regulations appears to be silent as to the filing of maintenance fees in an application.

Here, U.S. Patent Application Serial No. 08/098,896 (the original application) was filed on July 29, 1993, which is on or after December 12, 1980. The original application matured into U.S. Patent No. 5,453,758 (the original patent), having an issue date of September 26, 1995. Thereafter, U.S. Patent Application Serial No. 08/736,288 (the reissue application) was filed on October 24, 1996.

The periods specified in 37 C.F.R. §§1.362(d) and (e) with respect to a reissue application, including a continuing reissue application thereof, are counted from the date of grant of the original non-reissue application on which the reissued patent is based. 37 C.F.R. §1.362(h).

As explained within M.P.E.P. §1415.01, the filing of a reissue application does not alter the schedule of payments of maintenance fees on the original patent.

Whereas M.P.E.P. §2506 notes that maintenance fees for a reissue patent are due based upon the schedule established for the original utility patent, it is respectfully submitted that any requirement within U.S. patent practice and procedures for the payment maintenance fees in a reissue application appears to be absent from the Decision.

In light of the above, it is respectfully submitted that no clear statement can be found within the Decision as to why the events surrounding the reissue application would have been germane as to the delayed in payment of the 7 ½ year maintenance fee in the original patent.

Instead, the Decision requests clarification regarding the following:

1. The Decision asserts it is not clear that Ms. Miyamoto used the appropriate form.

Specifically, the Decision contends that the title of “Request for Final Disposition” appears inconsistent with the situation where a patent is to be maintained in force, and that use of “Request for Final Disposition” seems to match the circumstance where an application or patent is to be permitted to lapse.

In response, the “COMPAS” docketing system was in use at Sony as of May of 1998. The Request for Final Disposition form was used in May of 1998 to designate the status in the “COMPAS” docketing system of an application as an “inactive” application. Situations where the use of the Request for Final Disposition form would have been applicable are as follows:

- To abandon a case before filing in the Patent Office.
- To stop filing in a designated country of EP or WO.
- To abandon a request for examination.
- To abandon when received Office Action.
- An opposition from other parties has come effected.
- To abandon a patent or patent application by not paying renewal fee.

- Application change from Patent to Utility Model, or from Utility Model to Patent
- To transfer full right of a patent or patent application.
- To abandon the original patent once the reissue application grants.
- To revoke a final disposition to correct the input information.

2. The Decision questions whether the Request for Final Disposition was used because Ms. Miyamoto had assumed (incorrectly) that the prior patent/application was withdrawn/dismissed, as indicated by her use of status code 9, and whether she would have used the same form if she had not made an “incorrect” assumption.

In response, Ms. Miyamoto had assumed incorrectly in May of 1998 that the prior patent/application was withdrawn/dismissed, as indicated by her use of status code 9 in the Request for Final Disposition form. Specifically, the filing information of the reissue application was input by Ms. Miyamoto on May 6, 1998. On the same day, Ms. Miyamoto filled in the Request for Final Disposition of the original patent. The letter of June 26, 2006 from Ms. Takada explains the Sony docketing system record shows that an “*application withdrawn/dismissed*” entry (New-COMPAS status code “07”) was input to the database for the original patent on May 6, 1998 on the same day that an “*application filed*” entry (New-COMPAS status code “01”) was input to the reissue application.

A copy of the letter from Sanae Takada of Sony Intellectual Property Solutions Corporation dated June 26, 2006, which has been provided as ATTACHMENT G of the Petition of June 30, 2006.

A copy of the Sony docketing system record can be found as ATTACHMENT A of the Petition of May 17, 2007.

In May of 1998, Ms. Miyamoto was aware that the original patent was to be abandoned at some time after the filing of the reissue application. Routine business practice and procedures within Sony at the time of the error provide for the entry of status code 9 into the database of the COMPAS docketing system for the original patent once the original patent reissues. Nevertheless, the evidence of record highlights an error in judgment of Ms. Miyamoto in this instance as to the point in time when the abandonment of the original patent should have occurred. Had Ms. Miyamoto not made this "incorrect assumption", practices and procedures then in effect at Sony during May of 1998 would have precluded the use of the Request for Final Disposition form on May 6, 1998 regarding either the original patent or the reissue application.

3. The Decision inquires about the presence or absence of the proper clerical routine for the instance where a reissue application was pending and the underlying patent had not lapsed.

In response, proper clerical routines for the instance where a reissue application was pending and the underlying patent had not lapsed were in effect at Sony prior to and during May of 1998.

In particular, routine business practices and procedures within Sony would include the association of a Sony Reference Number with the original application. This Sony Reference Number would be useful in identifying the original application within the COMPAS docketing system. For example, Sony Reference Number S93P0482US00 has been used to identify the original application. This reference number would also be associated with the original patent once the original application has matured into a patent. The original application was filed with the U.S. Patent and Trademark Office on July 29, 1993. Accordingly, the prefix "93" within S93P0482US00 designates the filing year of the original application whereas the suffix "US00" within S93P0482US00 shows the original application as being the first U.S. application filed. "P0482" of S93P0482US00 is a unique application identifier associated with this application series.

Regarding the filing of the reissue application, practices and procedures within Sony would include the association of a Sony Reference Number of the original application with the reissue application. This Sony Reference Number would be useful in identifying the reissue application within the COMPAS docketing system. For example, Sony Reference Number S93P0482US00 has been used to identify the original application. Accordingly, Sony Reference Number S93P0482US01 has been used to identify the reissue application. While the unique identifier of "S93P0482" has remained the same within the Sony Reference Number for both the original and reissue applications, the suffix "US01" within S93P0482US01 shows the reissue application as being the first application related to the original application that has been filed subsequent to the original application.

As an example of this numbering scheme, the Sony letter of September 3, 1996 identifies Sony Reference Number S93P0482US00 as being associated with the original application and further shows Sony Reference Number S93P0482US01 as being associated with the reissue application.

A copy of the Sony letter of September 3, 1996 is provided along with this Petition as ATTACHMENT A.

Further examples of this numbering scheme can be found within the Sony docketing system record and the Request for Final Disposition, a copy of which being found as ATTACHMENT C of the Petition of May 17, 2007.

While a reissue application remained pending and the underlying patent had not lapsed, routine business practices and procedures within Sony would entail updating status of a reissue application using the same existing processes and systems for updating status of a non-reissue application. In this regard, these routine business practices and procedures required the status of the underlying patent to remain in the COMPAS docketing system as an active patent for the purposes of maintenance fee payments due during the pendency of the reissue application, thereby precluding the use of the Request for Final Disposition form (and the status codes listed thereon) regarding either the original patent or the reissue application.

Section 1415.01 of the M.P.E.P. explains that once an original patent reissues, maintenance fees are no longer due in the original patent, but rather the maintenance fees are due in the reissue patent. In accordance with U.S. patent practice and procedures, updating the COMPAS docketing system for scheduling maintenance fees in the reissue patent were within the Sony routine business practices and procedures.

Specifically, the Request for Final Disposition form is used in deactivating an application or patent within the COMPAS docketing system. A docketing administrator would enter status code 9 onto a Request for Final Disposition form upon grant of the reissue application on which the reissued patent is based. Thereafter, the supervisor of the docketing administrator would approve the entry of status code 9 by indicating such approval on the Request for Final Disposition form. The Request for Final Disposition requires a confirmation of the person assigned to annuity matters. But as noted previously within the Petition of May 17, 2007, there is no indication of the Request being forwarded to the person assigned to annuity matters for review and confirmation.

The database for the COMPAS docketing system would have been updated to “*abandon*” the original patent. This “*abandonment*” process within Sony would include the transference of scheduling information for the maintenance fee payments due in the underlying original patent to the data records for the granted reissue patent. The granted reissue patent (having the “RE” prefix) would then become the active patent within the COMPAS docketing system for the purposes of scheduling maintenance fee payments, whereas the *original patent number* for the underlying original patent would become inactive within the COMPAS docketing system.

Accordingly, a double submission of maintenance fee payments in both the granted reissue patent and the original patent would have been avoided through the use of then existing routine business practices and procedures.

As a routine business practice, Sony requests a quarterly Invoice from Computer Packages Inc. (CPI) as digital data and as a paper report. This Invoice includes a maintenance fee schedule listing the maintenance fee payments due in applications assigned to Sony during a specific period of time. The Sony reference number is the report index. Relevant data retrieved

from within the database of the COMPAS docketing system for issued patents having a status of “*not abandoned, not expired*” are then compared with the quarterly Invoice received from CPI.

As a courtesy, the U.S. Patent and Trademark Office will mail a Maintenance Fee Reminder and a Notice of Patent Expiration. M.P.E.P. §2575. Upon receipt of either Notice, routine business practices and procedures within Sony would include a status confirmation of the patent using information found within the COMPAS docketing system.

The presence of a Maintenance Fee Reminder dated April 16, 2003 and a Notice of Patent Expiration dated October 29, 2003 have been documented within the Petition of June 30, 2006. However, file histories for the original patent and the reissue application at both the Firm and Sony fail to show either Notice as being forwarded to or received by Sony prior to the expiration for the time period for paying the 7 ½ year maintenance fee due.

4. **The Decision questions whether Ms. Miyamoto had been properly trained in the proper clerical routine for the instance where the prior patent is in force, but there is a pending reissue application.**

The Decision requests evidence and employee reviews regarding the training that Ms. Miyamoto had received prior to May of 1998, and requests evidence regarding whether or not Ms. Miyamoto had been informed of the proper status code prior to May of 1998.

In response, training manuals and written reviews and other evidence that may have been available more than ten years ago for the training of Ms. Miyamoto are presently unavailable. Moreover, Ms. Nao Miyamoto received the training from two experienced workers, Ms. Motoko Kikuchi and Ms. Miki Tanae, both of whom have since left Sony.

The Decision requests evidence regarding whether or not the work of Ms. Miyamoto had been reviewed for the instance where a reissue application was pending and the underlying patent had not lapsed.

In response, specific evidence regarding whether or not the work of Ms. Miyamoto had been reviewed for the instance where a reissue application was pending and the underlying patent had not lapsed that may have been available more than ten years ago are presently unavailable.

5. The Decision questions the role of Mr. Tanaka.

The decision requests an explanation as to the reasons why Mr. Tanaka approved the work of Ms. Miyamoto.

In response, Mr. Tanaka was the manager of the Foreign Patent Administration Group in May of 1998. As manager one of his duties was the supervision of Ms. Miyamoto. Mr. Tanaka has since left Sony in 2005. In the supervising Ms. Miyamoto, only Mr. Tanaka reviewed the work of Ms. Miyamoto.

The Decision inquires as to whether Mr. Tanaka was properly trained in the clerical routine, and proper status code. While it is believed that Mr. Tanaka in his duty as the Foreign Patent Administration Group was familiar with these clerical routines, such evidence regarding the training of Mr. Tanaka that may have been available more than ten years ago is presently unavailable.

11 ½ YEAR MAINTENANCE FEE

A Notice of Non-Acceptance of Patent Maintenance Fee was mailed on March 20, 2007 in U.S. Patent No. 5,453,758.

The Notice indicates a payment receipt date of March 16, 2007 in the amount of \$3,800.00 as payment for the 11 ½ year maintenance fee payment due. However, the Notice further indicates non-acceptance of the 11 ½ year maintenance fee payment due pending the outcome of the instant Petition.

AUTHORIZATION-DUPLICATE COPY

MANNER OF PAYMENT

The Director is hereby authorized to charge Deposit Account # 18-0013 the sum of \$400.00.

AUTHORIZATION-DUPLICATE COPY

AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account # 18-0013.

AUTHORIZATION-DUPLICATE COPY

OVERPAYMENT

As to any overpayment made, please credit to Deposit Account # 18-0013.

ATTACHMENT A

September 3, 1996

Ronald P. Kananen, Esq
MARKS & MURASE
Suite 750, 2001 L Street, N. W.
Washington, D. C. 20036
U. S. A.

RECEIVED

SEP 8 1996

MARKS & MURASE

Re: New Patent Application in U. S. A.
according to the Patent Application in
U. S. A. No. 098896
Your present ref. : SON-417
present Sony File: S93P482US00

Dear Ronald P. Kananen, Esq

In connection with the above identified case,
please file a reissue application
in US patent office based on the present Patent
application No. 098896
on or before August 8, 1997.

Our reference number of the new application is
S93P482US01

We appreciate your cooperation in this matter.

Very truly yours,

Yoshikatsu Ono
General Manager
Intellectual Property Div.

YO: JK:

Encl.

P. S.

J. Kuranami

Application No. 08/098,896
Amendment dated November 28, 2007
Reply to Office Action of

Docket No.: SON-417

ATTACHMENT B



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

CHRISTOPHER M TOBIN
RADER FISHMAN & GRAUER PLLC
1233 20TH STREET NW
SUITE 501
WASHINGTON DC 20036



March 20, 2007

NOTICE OF NON-ACCEPTANCE OF PATENT MAINTENANCE FEEREGARDING PATENT NUMBER: 5453758

PAYMENT STATUS:

Payment Amount Received: \$ 3,800.00Payment Year 11.5 (e.g., 3.5, 7.5, 11.5)No charge was applied to your deposit account.PAYMENT RECEIPT DATE 03/16/2007
(Mailroom Date Stamp)**RECEIVED****DEC 06 2007**

Your payment was not accepted for the following reason(s):

- ☐ 1. The maintenance fee for the above-identified patent was previously paid on _____. **OFFICE OF PETITIONS**
☐ Information regarding the previous payment is stated in item 8 below.
- ☐ 2. The patent expired on _____. See "Patent Expiration" section below.
- ☐ 3. The fee was paid too early. See 37 CFR 1.366(b). Pursuant to 37 CFR 1.362(d), the payment window will open for the above-identified patent on _____.
- ☐ 4. Your payment was not sufficient to cover the maintenance fee and any required surcharge for the above-identified patent. An additional amount of \$ _____ is/was required.
- ☐ 5. The above-identified patent was reissued. In accordance with 37 CFR 1.366(d), the reissue patent number and reissue application number must be provided.
- ☐ 6. The payment did not include corresponding patent and application numbers, and was not specially accepted.
- ☐ 7. The above-identified patent is not subject to maintenance fees. No maintenance fees are due on utility patents filed before 12/11/80. No maintenance fees are due on design patents or on plant patents. See 37 CFR 1.362(a) and (b). (The "Resubmitting Maintenance Fee Payment" and "Patent Expiration" sections below do not apply.)
- ☒ 8. Other: PETITION FILED ON 06/30/2006 NO DECISION PLEASE WAIT ON DECISION BEFORE RESUBMITTING PAYMENT.

Resubmitting Maintenance Fee Payment

The six (6) month "grace period" for paying the maintenance fee for the above-identified patent ends on _____. In addition to the maintenance fee of \$ _____, a resubmitted payment filed in the USPTO during the 6 month "grace period" is required to include a surcharge of \$ _____. (See "Note" at the bottom of this Notice.)

To avoid patent expiration, the maintenance fee plus any required surcharge must be resubmitted in a manner that rectifies all of the indicated reason(s) for payment non-acceptance and *must be filed on or before the date the 6 month "grace period" ends*. Send by facsimile to the Office of Finance, Maintenance Fee Branch at (571) 273-6500, or by mail to the following address: Mail Stop M Correspondence, Director of the USPTO, P.O. Box 1450, Alexandria, VA 22313-1450, to the attention of the individual who has signed below.

Patent Expiration

The date the six (6) month "grace period" ends becomes the expiration date of the above-identified patent if the required amount for paying the maintenance fee is not filed in the USPTO by that date. See 37 CFR 1.362(g). Expired patents may be reinstated if a petition as set forth in 37 CFR 1.378 is granted. If the above-identified patent has expired and reason number 5 or 6 above is the only reason indicated for payment non-acceptance, it is possible that the payment may be accepted if resubmitted with a petition as set forth in 37 CFR 1.377, rather than 37 CFR 1.378.

If you have any questions regarding this Notice, contact the Office of Finance, Maintenance Fee Branch at (571) 272-6500. Please ask for the individual who has signed below.

Glenda Hinton (571) 272-6387

Printed Name of USPTO Representative

Glenda Hinton
Signature of USPTO Representative

NOTE: All USPTO fees (including patent maintenance fees) are subject to change. If you are making a payment, visit the www.uspto.gov website or contact the Office of Finance to verify the amount due on the date payment is to be made. A maintenance fee payment can be timely made using the certificate of mailing or transmission procedure set forth in 37 CFR 1.8.